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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/591,124	10/03/2006	Abraham J. Domb	27617U	7340
20529 7590 03/02/2009 THE NATH LAW GROUP 112 South West Street Alexandria, VA 22314				
EXAMINER JOHNNIE, JOSEPH G				
ART UNIT		PAPER NUMBER		
4118				
MAIL DATE		DELIVERY MODE		
03/02/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/591,124

**Applicant(s)**

DOMB ET AL.

**Examiner**

JOSEPH JOHNNIE

**Art Unit**

4118

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 1-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election without traverse of Group III claims 18-24 in the reply filed on 1/26/2009 is acknowledged. Claims 1-17 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 18 and 21-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Regarding claim 18, the phrase "and/or" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention, more specifically whether the applicant means and or or. See MPEP § 2173.05(d).

5. Claims 21-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Regarding claims 21-24, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaneko et al.

9. Re claim 18, Kaneko et al discloses a sponge 48 carrying a data transmitting module (fig. 12, and column 10, lines 13-29) except for the ability to absorb and hold at least 30% w/w aqueous solution. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a sponge which can hold at least 30% w/w aqueous solution, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

10. Re claim 19, Kaneko discloses that the transmitting module is a chip 1a (fig. 12, and column 10, lines 13-29).

11. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaneko et al as applied to claim 18 above, and further in view of Suzuki (US Patent No. 4,477, 626).

12. Re claim 20, Kaneko discloses the claimed invention except for a water protecting coat. However, Suzuki teaches the use of a water resistant coat in order to

protect semiconductor chips (column 6, lines 9-16). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention was made to modify Kaneko's reference, to include a water-resistant coating for the chip, as suggested and taught by Suzuki, for the purpose of protecting the chip from any potential water damage.

13. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaneko et al as applied to claim 18 above, and further in view of Meyer (US Patent No. 4,148,318)

14. Re claim 21, Kaneko discloses the claimed invention except for the sponge is made of urethanes. However, Meyer teaches the use of a polyurethane sponge (refer column 1, line 51-53) in order to take advantage of the hydrophobic properties of the polyurethane material. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention was made to modify Kaneko's reference, such that the material of the sponge is made of polyurethane, as suggested and taught by Meyer, for the purpose of protecting the sponge from water-soluble materials.

15. Claims 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaneko et al as applied to claim 18 above, and further in view of Nicolais et al (US Patent 5,645,592).

16. Re claim 22-24, Kaneko discloses the claimed invention except for the sponge being made of hydrophilic substances, polymers, or more specifically, hydrophilic-hydrophobic copolymers such as HEMA-methyl methacrylate. However, Nicolais teaches the use of HEMA-methyl methacrylate (column 7, lines 20-44), in order to

increase water absorption. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention was made to modify Kaneko's sponge by coating it with HEMA-methyl methacrylate, as suggested and taught by Nicolais et al, for the purpose of increasing water absorption, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

### ***Conclusion***

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSEPH JOHNNIE whose telephone number is (571)270-7838. The examiner can normally be reached on Monday-Friday, 7:30am-5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Quang Thanh can be reached on 571-272-4982. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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